

Remarks

Claims 1-20 are pending in this application. Claims 1, 2, 5, and 10-18 have been withdrawn. Claims 3, 4, and 6-9 have been rejected.

Restriction / Election of species

Applicants confirm the election of restriction group (II) and of the species of example 72 for as the starting point for further prosecution in this application. However, applicants request reconsideration of the scope of the restriction requirement, for reasons to be provided below.

In the official action, the examiner has mischaracterized the applicants' traversal of the original restriction requirement. However, this will not be argued further at this time as to do so would be pointless.

In preparing to respond to the official action, the undersigned studied the examples, the claims, and the details of the restriction requirement dated 01/11/2005, and came to the realization that the application contains 279 experimental examples of compounds of the invention, but only 6 of these are covered by broad claim 3 if it is amended in accordance with the restriction requirement. This is unfair to the applicants, and unacceptable.

The applicants understand that the examiner wishes to split the claims of the application into smaller units which can be examined without having to search too many classes and subclasses of the classification system. However, in making a restriction requirement, the examiner should not define the claim variables so narrowly that the amended broad compound claim is a first cousin to a species claim, as has been done here. To do so admittedly makes the examiner's life easier, but imposes a severe hardship on the applicants, who must ultimately file many continuing applications just in order to have patent coverage of the exemplary compounds, not to mention any scope around the examples. In the present case, if each continuing application were to cover only 5 or 6 of the exemplary compounds, the number of continuing applications would be in the range of 46 to 56 cases. That would be unreasonable.

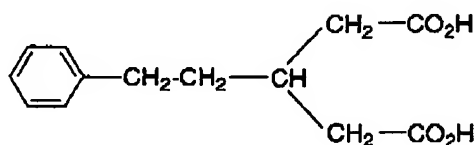
Accordingly, the applicants request that the examiner reconsider and revise the restriction requirement so that after splitting the broad claim into subunits which the examiner considers to

be manageable, the number of such subunits does constitute an undue burden on the applicants to file and prosecute.

The claims of this application are not being amended at this time to bring them into correspondence with the present restriction requirement, because this would be wasted effort if the examiner agrees to revise the original restriction requirement as requested above. Appropriate amendments will be made later in prosecution.

Rejection under §102(b)

The examiner has rejected claims 3, 4, and 6-9 under §102(b) as anticipated by the Jones reference identified in the office action, which the examiner states discloses the compound of formula



This compound does not anticipate the present claims as modified by the restriction requirement, because it does not contain a double bond in the portion corresponding to the "W" portion of formula (I).

Double patenting

In the Office action, the examiner rejected claims 3, 4, and 6-9 for obviousness-type double patenting in view of "copending application number 10/070033". Applicants inform the examiner that the reference application issued as patent no. 6,864,287 on March 8, 2005. It is deemed not to make the present claims as modified by the restriction requirement obvious because there is no suggestion that the claims of the reference should be modified in such a manner as to convert them into the present claims as modified by the present restriction requirement. A listing of the selections and modifications which would be necessary to convert the claims of the reference into the present claims as modified by the present restriction requirement will demonstrate that there should be no obviousness-type double patenting problem.

Respectfully submitted,



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